

reached at that time, pending the Examiner's further consideration of the arguments there presented by Applicants. However, the Examiner indicated that in view of the prohibition in 37 C.F.R. § 1.176 and MPEP § 1450 against requiring a restriction amongst the original claims, Applicants are not required to respond to the election requirement of paragraph 1 of the Office Action.

As was also discussed in the interview, the withdrawal of Claims 30-31 from consideration (paragraph 2) is also respectfully traversed. The Examiner has alleged that these claims are directed to an independent or distinct invention because the word "entire" is not present in Claims 30-31. However, the Examiner has not explained why this broadening represents a distinct or independent invention. Specifically, the Examiner has not referred to any of the required criteria for independence or distinctness set forth in MPEP § 806.04-806.05, nor has the Examiner alleged that any of the required reasons for insisting on a restriction are present. MPEP § 808.02. The examination of Claims 31-32 is therefore respectfully solicited.

Claims 17-20 and 24 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Claim 28 was again rejected under 35 U.S.C. § 251 and under 35 U.S.C. § 102 as being anticipated by Barry et al and Tong et al. Claim 29 was also rejected under 35 U.S.C. § 251, under 35 U.S.C. § 112, first and second paragraphs, and under 35 U.S.C. § 102 as being anticipated by Tong et al. The remaining claims were allowed. Considering these matters in order:

#### I. CLAIMS 17-20 AND 24

These claims depend from Claim 1 and further define the intermediate layer. For example, according to Claim 17 the intermediate layer extends over the entire surface of the

ground contact layer, and also recites that it includes a succession of rigid inserts. There is no inconsistency between these limitations. According to Claim 19 the intermediate layer extends over the entire surface of the ground contact layer and includes two arc shaped recesses. However, there is no requirement in Claim 19 that the arc shaped recesses are located over the ground contact layer, and so they would not detract from the intermediate layer extending over the entire surface of the ground contact layer. According to Claim 24 the intermediate layer extends over the entire surface of the ground contact layer, which has points extending through the intermediate layer. However, the recitation of these points is not inconsistent with the intermediate layer shown in, e.g., Figs. 15-16, extending over the entire ground contact layer. Thus the above claims are believed to be definite under 35 U.S.C. § 112, second paragraph.

Nonetheless, new Claim 32 has been introduced Claim 32 corresponds to Claim 17 but recites that the intermediate layer extends over *substantially* the entire surface of the ground contact layer. If, as the examiner has alleged, there is an inconsistency in Claim 17, it would not be present in Claim 32.

## II. REISSUE RECAPTURE

As applicants have previously explained, Claims 28-29 do not attempt to improperly recapture previously surrendered subject matter **because they are narrower than the cancelled claim in an aspect germane to a prior art rejection.** See Section I. of the previous response.

In response to the remarks of the previous response, the Examiner has now noted (in paragraph 12) that the original application included a dependent claim which recited a sole whose layers “extends or does not extend over its entire surface.” However, even this claim

is broad enough to include a layer having a minimal extent, and so is broader than Claims 28-29 as to the area extent of any layer.

The Examiner has also relied upon *Pannu v. Storz Instruments Inc.*, 59 USPQ2d 1597 (Fed. Cir. 2001). However, it is respectfully submitted that this reliance is misplaced. In *Pannu*, the applicant had amended the claims of the original application to recite “a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference” — a shape limitation. During reissue, the patentee proposed deleting this phrase entirely in favor of a recitation that snag resistant means is “at least three times greater in width than the width of said flexible elements, said snag resistant elements and said positioning and supporting elements being substantially coplanar.” Concerning reissue recapture, the patentee argued that “what is gained by the elimination of one limitation is given up by the addition of the other limitations.” 59 USPQ2d at 1600. The court disagreed because:

The “continuous, substantially circular arc” limitation related to the shape of the haptics. The narrowing aspect of the claim on reissue, however, was not related to the shape of the haptics, but rather the positioning and dimensions of the snag resistant means. Therefore, the reissued claims were not narrowed in any material respect compared with their broadening. (59 USPQ2d at 1600-1601).

Thus the court did not hold that reissue recapture prevented any broadening of the claim, even as to completely eliminating a limitation which was added to gain patentability. It only required that a narrowing limitation also be present and relate to the surrendered subject matter which was broadened — a broadened shape limitation must be replaced with a narrowing shape limitation, and not a position or dimension limitation.

Here, as Applicants have previously described, the claims were narrowed during the original prosecution to recite the area extent of the intermediate layer relative to the ground

contact layer, and so any surrender related to the area extent of the intermediate layer relative to the ground contact layer. Applicants are not attempting to return to a claim scope which was surrendered as to the area extent of the intermediate layer relative to the ground contact layer, i.e., no restriction as to this area extent. Instead, as compared to the claim scope of the original application which was surrendered to gain patentability, the reissue claims 28-29 are narrowed as to require a substantial limitation as to the area extent of the intermediate layer relative to the ground contact layer. *Pannu* thus supports the patentability of Claims 28-29.

### III. REJECTION OF CLAIM 29 UNDER 35 U.S.C. § 112

Claim 29 again stands rejected under 35 U.S.C. § 112, first paragraph, as allegedly being based upon disclosure which is not enabling. It is the position of the Examiner that the claimed function of Claim 29 requires that the intermediate layer must extend over a substantial surface of the sole, not merely over the lateral heel portion. In response to Applicants' prior remarks, the Examiner has now stated (paragraph 12) "In order for the intermediate layer to function as claimed, it would have to cover a substantially (sic) portion of the ground contact layer. *There is no disclosure contrary to such*" (emphasis added).

Thus it is the Examiner's position that all limitations may be viewed as being critical unless the specification explicitly indicates otherwise. This, however, is not correct. As Applicants have explained:

Limiting an application to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress of useful arts. Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made *only* when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. *Broad language in the disclosure, including the Abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality.* (MPEP § 2164.08(c); emphasis added).

Thus the burden under 35 U.S.C. § 112, first paragraph is not on Applicants to show that the disclosure of the specification is contrary to the Examiner's allegation of criticality for a given limitation, but is instead on the Examiner to establish criticality for enablement based on the specification. The present specification broadly describes the invention without mention of the extent of the area of the intermediate layer. The "Summary of the Invention" states that the intermediate layer is "arranged directly between the upper part of the contact layer, by one of its faces, and the lower part of the comfort layer, by its other face, and exhibiting controlled torsional and flecnal rigidity, and which provides simultaneously for the distribution of the shock areas sensed by the contact layer and their diffusion over the comfort layer, before coming in contact with the foot." The area of extent of the layer is not mentioned. Thus the language of the specification rebuts this rejection.

For the same reason, there is no support for the Examiner's allegation that Claim 29 is indefinite under 35 U.S.C. § 112, second paragraph, because the recited structure does not support the claimed function of providing for the distribution and diffusion of shockwaves and stresses.

#### IV. REJECTIONS UNDER 35 U.S.C. § 102

Claim 28 again stands rejected under 35 U.S.C. § 102 as being anticipated by the U.S. patents to Tong et al or Barry et al.

Claim 28 recites that the intermediate layer extends "over substantially an entire surface of said ground contact layer which is located directly beneath a foot of a person wearing the sport shoe." As was previously explained, there is no teaching for these features in Tong et al or in Barry et al.

For example, the insert member 56 in Tong et al (Figures 4-5) extends only in the heel area of the sole (see Fig. 4). It is thus not present at the fore half of the sole. The insert member is also limited in area by the spaces between the lateral extensions 60-72. Even a cursory examination of Tong et al thus indicates that the insert member 56 extends over *less than one half* of the ground contact layer which is located directly beneath a foot of a person wearing the shoe. **This is a structural — not a functional — difference between Tong et al and claim 28.**

The insert member 120 of Tong et al (Figure 16) is also limited and has significant spaces between the lateral extensions at the heel and between the fingers 122, and so the above remarks regarding insert member 56 apply here as well, i.e., it is limited in extent and cannot reasonably satisfy the plain meaning of an intermediate layer which extends “over substantially an entire surface of said ground contact layer which is located directly beneath a foot of a person wearing the sport shoe.” **This is also a structural — not a function — difference between Tong et al and claim 28.**

The Examiner has referred to Applicants’ having previously alleged “some sort of minimal test” for “substantially an entire surface,” a test which is allegedly not met by Tong et al. The Examiner has stated that the claims are given their broadest reasonable interpretation. However, the “broadest reasonable interpretation” test is the same test as that which was urged by Applicants. The “broadest reasonable interpretation” test simply means that the Examiner can give the claim terms their “plain meaning” which would be understood by those of ordinary skill in the art. MPEP §2111.01. The insert members 56 or 120 of Tong et al extends over only a small part of the ground contact layer which is located directly beneath a foot of a person wearing the shoe. The “plain meaning” of “substantially an entire”

extent cannot include such a small portion. Thus the broadest **reasonable** interpretation of this claim term is not met by Tong et al.

Of course, the spring plate 17 of Barry et al is not present at the lateral part of the heel, and so also does not correspond to the plain meaning of an intermediate layer which extends “over substantially an entire surface of said ground contact layer which is located directly beneath a foot of a person wearing the sport shoe.” Thus the broadest **reasonable** interpretation of this claim term is not met by Barry et al.

Claim 29 recites that the intermediate layer has “controlled torsional and flectional rigidity.” The only portions of the insert members 56 and 120 of Tong et al present directly beneath a lateral portion of the heel are the lateral projections 60-72 (and the corresponding parts in Figure 16). However, these are merely cantilever projections which are inherently incapable of comprising structure having the “controlled torsional and flectional rigidity” recited in the claims. Thus, Claim 29 also defines over Tong et al.

New Claim 32 recites that the intermediate layer comprises, at least in the metatarsal area, a succession of rigid inserts arranged in alternating fashion perpendicularly to the axis of torsion of said sole. This is not taught by Tong et al or Barry et al.

## V. OTHER MATTERS

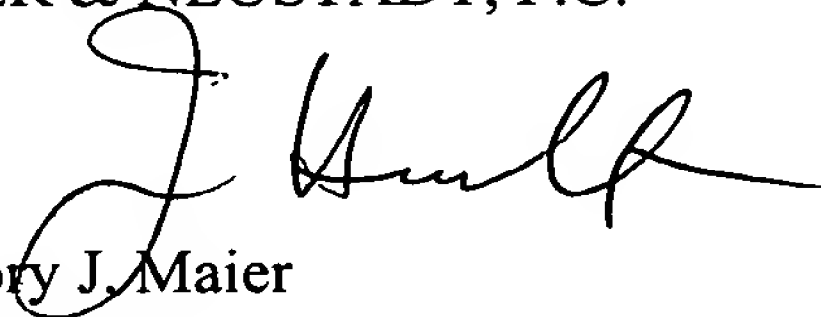
The original patent, or a statement as to loss or inaccessibility of the original patent, will be submitted once all remaining issues have been resolved.

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Applicants therefore believe that the present application is in a condition for allowance and respectfully solicit an early notice of allowability.

Respectfully submitted,

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IN THE CLAIMS

Claim 32 (New)